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First Named Inventor	Abe Nishiki
Art Unit	3734
Examiner Name	Christina D. Gettman
Attorney Docket Number	

ENCLOSURES (Check all that apply)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Abe Nishiki

Appeal No. _____

Serial No.: 10/687,748

Group Art Unit: 3734

Filed: 10/20/2003

Examiner: Gettman, Christina D.

For: **A PLIERS-LIKE TOOL AND PROCESS FOR CURING PHIMOSIS**

* * * * *

REPLY BRIEF

* * * * *

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Members of the Board of Patent Appeals and Interferences:

The jurisdiction of the Board is invoked under 35 USC 134 and 37 CFR 1.191. A Notice of Appeal and payment therefor and payment for filing a Brief were filed March 20, 2008.

It is requested that the Appeal previously paid for be maintained. That brief was filed in response to the Examiner's Third New Grounds of Rejection in this application mailed 12/28/2007. That Notice of Appeal and Appeal Brief were timely filed.

This Reply Brief is timely filed in response to the Examiner's Fourth New Grounds of Rejection and first new grounds of rejection mailed on 10/02/2008 in response to the Appeal Brief mailed March 20, 2008.

The most pertinent portion of the Appeal Brief of march 20, 2008, is reproduced herewith for convenience.

Table of Contents

<u>Item</u>	<u>Page</u>
Identification	1
Table of Contents	2
i. Real party in interest	4
ii. Related appeals and interferences	5
iii. Status of claims	6
iv. Status of amendments	7
v. Summary of claimed subject matter	8
vi. Grounds of rejection to be reviewed on appeal	10
vii. Arguments	11
Meyer	11
Sakashita	11
Cox	12
Seber et al	12
Tiedemann	13
Tillier	13
Roux	13
35 USC 103(a) Rejections	
Claims 1, 2, 9, 11 and 12 (Meyer and Sakashita)	14
Claims 3 and 5, with 12 (Meyer, Sakashita and Cox)	16
Claims 4, 6, 7 and 8 (Meyer, Sakashita, Cox and Seber et al)	17

Table of Contents (Cont.)

<u>Item</u>	<u>Page</u>
Claim 10 (Meyer, Sakashita and Tiedemann)	19
Claims 13, 14 and 15 (Meyer, Sakashita and Tillier)	19
Claim 16 (Meyer Sakashita and Roux)	21
Applicable Law	21
35 USC 103(a) Rejections	22
1. Claim Preamble	22
2. Non-analogous Art	23
3. Function Ignored	23
4. Problem Addressed	24
5. Combining Prior Art References	25
6. References Require Modification	26
7. Hindsight	26
35 USC 103(a) Summary	27
Conclusion	29
viii. Claims Appendix	30
ix. Evidence Appendix	36
x. Related Proceedings Appendix	37

i. Real Party of Interest

The real party of interest is Abe Nishiki whose mailing address is: 121-9, Aza Maehata, Oh-Aza Myogazawa, Matsuyama-machi, Atsumi-gun, Yamagata Pref. Japan

ii. Related Appeals and Interferences

There are no known related appeals or interferences.

iii. Status of Claims

Claims 1-19 are present in this application.

Claims 1, 2, 9, 11 and 12 are rejected 35 USC 103(a) as being over Meyer (U.S. Patent No. 6,325,625) in view of Sakashita (U.S. Patent No. 5,370,569).

Claims 3 and 5 are rejected under 35 USC 103(a) as being unpatentable over Meyer and Sakashita, as in claim 2, in view of Cox (U.S. Patent No. 4,754,746).

Claims 4 and 6 - 8 are rejected under 35 USC 103(a) as being unpatentable over Meyer, Sakashita and Cox, as in claim 3, taken with Seber et al (U.S. Patent No. 6,748,829).

Claim 10 is rejected under 35 USC 103(a) as being unpatentable over Meyer and Sakashita, as in claim 9, in view of Tiedemann (U.S. Publication No. 2003/0233119).

Claims 13 - 15 are rejected under 35 USC 103(a) as being unpatentable over Meyer and Sakashita, as in claim 1, in view of Tillier (U.S. Patent No. 1,477,786).

Claim 16 is rejected under 35 USC 103(a) as being unpatentable over Meyer and Sakashita, as in claim 2, in view of Roux (U.S. Patent No. 4,124,929).

Claims 17 - 19 are withdrawn from consideration under 37 CFR 1.142(b) as being drawn to a non-elected invention.

iv. Status of Amendments

There are no pending amendments.

v. Summary of Claimed Subject Matter

As set forth in the only independent claim 1, and dependent claims 2 - 16, the basic invention is disclosed in the Abstract (page 22 of the Specification). A plier-like device has handles 2L, 2R, that fulcrum on pivot pin 5 such that jaws 4R, 4L have upturned blades 3R, 3L with end ball hooks 3a that separate as the handles are brought together. A rack 8 pivots on a pin 9 to position the blades by use of pawl 7 (Figs 1 and 2; page 5, lines 5 through 20). These are set forth in claims 1 - 3, 5, and 9 - 12. The rack can have a guide groove 14, accommodating a spring-loaded projection 12, with a stop 16 to limit pivotal movement. The guide groove has a tapered surface at one end 14a to disengage the rack from the projection (page 9, lines 5 - 21) claims 6 - 8. As shown in Fig. 5, (page 11, lines 1 - 12) the rack can have an internal slit or slot 23, that accommodates a pawl 7, as set forth in claim 4. As shown in Fig. 6, the handles 32L, 32R, jaws and blades 34L, 34R can all be one integral shaped spring element (page 12, line 19 - page 13, line 16) with a flat rack 37 having cogs 38 that engage with the handle 32L of the spring element 31, claims 13 - 15. The fulcrum 5 includes a spring to open the grips 2R and 2L while closing the blades 3R and 3L (page 5, lines 8 and 9), claim 16.

Claims 1 - 3, 5 and 9 - 12 address the handle, jaw, blade, ratchet, and details of the enlarged hook means shown in Figs. 1 and 2.

Claim 4 adds to claim 3 the rack having a slot 23 that accommodates the pawl shown in Fig. 5.

Claims 6 - 8 add to claim 3 the rack having a guide groove 14 for accommodating a spring projection controlling rack movement of Fig. 1.

Claims 13 and 14 add to claim 1 that the handle, jaw and blade are all one integral shaped spring element as shown in Fig. 6.

Claim 15 adds to claim 14 the flat rack 37 having cogs on one side that engage one handle of the integral spring element.

Claim 16 adds to claim 2 a spring 10 with the fulcrum pin 9 for biasing the cogs on the rack 8 toward the pawl 7.

vi. Grounds of Rejection to be Reviewed on Appeal:

If claims 1, 2, 9, 11 and 12 are obvious over Meyer in view of Sakashita.

If claims 3 and 5 are obvious over Meyer and Sakashita in view of Cox.

If claims 4 and 6 - 8 are obvious over Meyer, Sakashita, and Cox in view of Seber et al.

If claim 10 is obvious over Meyer and Sakashita in view of Tiedemann.

If claims 13 - 15 are obvious over Meyer and Sakashita in view of Tillier.

If claim 16 is obvious over Meyer and Sakashita in view of Roux.

Claim Grouping

Of the claims, claim 1 and claim 3 and claim 4 and claim 6 and claim 8 and claim 9 and claim 15 are considered to be independently patentable.

Claims 2, 11, 13, 14 and 16 are considered to be grouped with and patentable with claim 1.

Claims 5 and 12 are considered to be grouped with and patentable with claim 3.

Claim 7 is considered to be grouped with and patentable with claim 6.

Claim 10 is considered to be grouped with and patentable with claim 9.

vii. Arguments

Meyer and Sakashita are used as the base or primary references in all the rejections. Meyer is to a “Dental Separator and Matrix/Stabilizing Device” and Sakashita is to “Grasping Forceps for Medical Treatment.” For purposes of these arguments it will be assumed that the examiner read the claims and references. The examiner incorporates 5 additional references that are purported to show various elements of the claimed combination to reject the claims. Cox, Seber et al, Tiedemann, Tillier and Roux. The claims are drawn to a phimosis curer. Not one of the references discloses a phimosis curer.

Meyer

Meyer (U.S. 6,325,625) discloses eight different embodiments of a “Dental Separator and Matrix Stabilizing Device” (Title, Figs. 1, 8, 11, 12, 14, 16, 18 and 20). The separator and matrix stabilizers are inserted with a spreading forceps 58 having teats 56 of rubber-dam on the clamp - spreading forceps (Fig. 4, column 5, lines 13 - 16). The spreading forceps 58 are of the standard pliers type having two handles that cross each other at a pivot and, on bringing the handles together, the right angled “teats” also come together and, on separating them away from each other or moving them apart, the “teats” also move apart (47, Fig. 1; column 6, lines 38- 48).

Sakashita

Sakashita (U.S. 5,370,659) discloses thirteen embodiments of a “Grasping Forceps for Medical Treatment” (Title, Brief, Description of the Drawings, Fig. 19B; column 3, lines 47 - 50). The device has handles that operate remote forceps 27a, 27b through a mechanical linkage

(Figs. 1, 3 and 4; column 4, lines 1 - 24). A ratchet means 8 is provided for locking the handles in the open, spaced apart position in which the handles are separated and the blades are closed in the clamping position (Figs 1 and 7; column 6, lines 25 - 31). The leaf spring 109 on the movable handle 30, biases the locking member 101 (ratchet with cogs 103) through a "slit-like hole 104" toward a leaf spring ratchet pawl 106 held by a set screw 107 on the fixed handle 28 (column 6, lines 31 - 45; column 8, lines 9 - 16).

Cox

Cox (U.S. 4,754,746) discloses a "Self-Retaining Metatarsal Spreader." Handles 1, 2 move blades B toward and away from each other about a pivot 3 with ratchet means 6 - 12 for holding the blades in the open position and the handle in the closed position (Abstract; Fig. 1; column 2, lines 30 - 57; column 3, lines 22 - 38). The ratchet 6 is integral with and rigidly fixed to the handle 1 and does not pivot about a pivot pin on that handle, and the ratchet cannot pivot toward and away from the pawl 9 (column 2, lines 30 - 48).

Seber et al

Seber et al (U.S. 6,748,829) discloses five separate embodiments of "Self-Adjusting Pliers" (Title, Brief description of the Drawings; Fig. 17; column 4, lines 30 and 31). In each of the embodiments one handle 22 has a blade 24 integral while a second handle 56 is separate from the second blade 76 and pivots 98 therewith. Two slots 40, 42 provide for a slider 84, to keep the lower jaw 78 perpendicular to the upper jaw 24, and a pawl 86 (column 5, line 58 - column 6,

line 23). The pawl provides for adjusting the distances between the blades 24,76 (column 6, lines 46+).

Tiedemann

Tiedemann (U.S. Publication No. 2003/0233119) is to a “Port Deaccessor and Methods of Use.” The forceps 10 have non-slip coating 25 (Fig. 3; Abstract; paragraph [0026]). When the handles (arms) 12 are pressed together the ends 16 are pressed together.

Tillier

Tiller (U.S. 1,477,786) is to a “Piston Ring Expanding Tool.” The expander is made from a single strip of spring metal bent into a handle 5 and jaws that cross each other 8 with jaw extensions 9 with recesses 10 on the jaw ends. When the handles are brought together the jaw ends expand apart.

Roux

Roux (U.S. 4,124,929) is to an “Extractor for Watch Push Buttons” having expanding pliers with one jaw carrying a pressing stud for engaging the sleeve of a watch push button while the other jaw bears against the opposite wall (Title; Abstract). There are springs 19 between the handles for pressing the jaws and handles open (column 2, lines 51 - 57).

Claims 1, 2, 9, 11, 12

Claims 1, 2, 9, 11 and 12 are rejected under 35 USC 103(a) as being unpatentable over Meyer in view of Sakashita.

To avoid future confusion, claim 12 is addressed with the rejection of claim 3. The rejection of claim 12 with claim 1 is confusing as claim 12 depends from its parent, claim 3, and was previously rejected therewith.

The claims are drawn to a phimosis curer. The structure claimed is specifically associated with its use (claim 1, lines 12 and 13 and lines 21 - 29). Neither Meyer or Sakashita suggest their structures for the claimed use. Contrary to the speculative opinion of the examiner, this structure is not shown to be obvious or the modification to be within the skill of the mechanic.

Sakashita adjusts the spacing between gripping members 27a and 27b of the organ remover by moving the gripping handles by forcing the handles 28,30 toward and away from each other. Moving the handles together moves the gripping members together (column 4, lines 1 - 24; column 7, lines 5 - 21; Figs. 1 and 8A). The examiner has misconstrued the structure and function of the ratchet means 8 of Sakashita. Since the movement of the handles 28,30 apart moves the blades apart, and since the movement of the handles together closes the blades, and since the teeth 103 of the ratchet 8 are tapered to permit the handles 28 and 30 to freely come together but prevents them from separating (column 6, lines 25 - 45; Figs. 1, 7, 18A, 19A) the ratchet prevents opening not closing.

Meyer adjusts the space between tines 46 of dental separator 40 by moving the teats 56 of instrument 58 closer together or moving them apart. Moving the handles together moves the tines together. When Meyer brings his handle grips apart the blades go apart. The physical

showing and disclosure of Meyer are consistent, but the examiner's interpretation is erroneous. The frequent recitation of spreading in Meyer refers in part to the spreading of teeth that the device 40 is designed for (Abstract; Fig. 1, 47; Fig 4; and column 6, lines 38 - 48).

The lack of understanding on the part of the examiner is demonstrated on page 4, lines 1 - 4, of the 10/02/08 rejection when it is stated that the ratchet of Sakashita in Meyer would be obvious "in order to keep the blades from separating from one another while inserting the dental separator." The statement is erroneous as to both the use and function as the claimed structure keeps the blades separated while within a foreskin curing phimosis position. When Sakashita uses a ratchet to prevent the handles 28,30 from separating, the ratchet prevents the blades 27a, 27b from opening when the claimed ratchet prevents closing, (note also column 13, lines 51 - 66). The ratchet means claimed prevents the blades from closing to keep tension on the foreskin. Contrary to the proposed modifications made to Meyer and Sakashita, the references both teach away from the claimed structure and the modifications made to combine their teachings would render the claimed device inoperative. There is no suggestion or disclosure in either Meyers or Sakashita to make the combination that would render the claimed structure or function obvious.

The examiner "brushes off" the totality of the claimed hook means structure recited in claim 1, lines 21 through 29. This structure of the blades enables the curer device to fit within the foreskin without damaging it while independently retained there for some time. Neither of the references teach this structure and neither reference teaches this use, and neither reference is capable of functioning as the claimed structure does.

The handle and blade movements are opposite.

The ratchet functions are opposite.

The hook structures are different.

The claimed structure is not obvious in view of the patents to Meyer and Sakashita in view of each one of the above differences.

Claims 3 and 5 (With Claim 12 Included)

Claims 3 and 5 are rejected as in claim 2 (Meyer in view of Sakashita) taken with Cox.

Claim 12 is included here as it depends from claim 3.

The patent to Cox was previously used in both a 35 USC 102(b) rejection (claims 1, 2 and 11) and a 35 USC 103(a) rejection (claims 3 - 8 and 12). Cox was addressed in detail on pages 11 and 12 of the Appeal Brief and with respect to claims 3, 5 and 12 on pages 13, 14, 15 and 17. Those statements addressing Cox are incorporated by reference.

Claim 3 recites the details of the ratchet means. It requires a curved rack with cogs and a pawl with the rack that is attached to the first handle second end by a first pivot pin and the pawl to be attached to the second handle second end by a second pivot pin. Cox only has one pivot pin. Claim 5 requires the rack cog surface to pivot toward the pawl and away from the pawl. The ratchet means 6 of Cox does not pivot. It, therefore, does not meet the structure required by either claims 3 or 5.

Cox does not teach a phimosis curer and the structure for the claimed phimosis curer and the bone gripping and spreading “metatarsal spreader” of Cox are not the same.

The pawl of Sakashita is not attached by a “second pivot pin.”

Claim 12 depends from claim 3 and is allowable therewith. Claim 12 requires bias means on the first pivot pin for biasing the cogs. The cogs 7 of Cox are stationary on the rack 6 that is

stationary on the handle 1 so there cannot be a biasing movement of the rack to the pawl. Since the references do not teach a rack biased toward a pawl, they cannot render claim 12 obvious. None of the references teach cog biasing means on a pivot pin.

Claims 4, 6, 7 and 8

Claims 4, 6, 7 and 8 are rejected as claim 3 (Meyer, Sakashita and Cox) taken with Seber et al. The examiner contends that Seber et al in Figs. 2A and 3A teach a curved rack with a slot “for the purpose of allowing the pawl to move within the curved rack.” Your applicant has been unable to find a Fig. 2A or a Fig. 3A in Seber et al. It is assumed that Figs. 2 and 3 are intended.

Seber et al’s patent is to a “Self-Adjusting Pliers.” Like Meyer and Sakashita two handles, such as 34, 50, when pulled together close jaws 24,76 together to clamp on an object 32 (cover page). As with all five embodiments, one of the jaws is separated from its handle and independently pivoted from a pivot pin such as 98.

The proposed modification of Meyer by the teachings of Seber et al is a reconstruction whereby the totality of the device is changed to a never intended structure or use. Meyer’s use is to spread and contract 47 (Fig. 1) to adjust matrix stabilizing devices 40 using teats on a standard type pliers while Seber et al is to adjust the spacing of jaws to accommodate and clamp on different diameter objects. There is no justification or need to modify Meyer and a ratchet in Meyer would render his pliers 58, 56 inoperative in at least one direction if not in total because it is necessary to “open and close” the teats to accommodate adjustment 47,60 (Fig. 1; column 5, lines 5 - 22). The pawl of Seber et al is not a part of the handle 56 or the handle 34, it is attached to the independently pivotable jaw 76 and the “support” 38 having “teeth” 46 does not pivot but

is an integral solid part of handle 34 and the “teeth” 46 do not “prevent” the handle grips from moving away from each other as required by parent claim 1.

Claim 4 depends from claim 3 and is allowable therewith and is independently patentable.

As to claim 4, not one of Meyer, Sakashita, Cox or Seber et al teach a curved rack attached to a first handle grip, second end, by a pivot pin with a pawl attached to the second handle grip, second end, by a second pivot pin with a slot 23 along its interior length. None of the references teach the rack and pawl required by claim 4 and shown in Fig. 5. Since none of the references teach the structure claimed they cannot teach nor render the claimed structure obvious.

Claim 5 depends from claim 3 and is allowable therewith.

Claim 6 depends from claim 3 and is allowable therewith and is independently patentable.

Claim 6 requires a curved rack with a lower surface having a guide groove 14. None of the references have a curved rack with a guide groove. Since none of the patents teach the claimed structure, they cannot render the claim obvious. Not one of the reference teaches a spring-loaded projection for maintaining contact with a groove. Claim 6 is not obvious over the combination of references.

Claim 7 depends from claim 6 and is allowable therewith. In addition to the structure and function of claim 6, claim 7 includes the limitations that the projection in the groove controls movement of the rack with respect to the pawl. Claim 7 is not obvious over the references.

Claim 8 depends from claim 7 and is allowable therewith and is independently patentable.

In addition to the structure of claim 7, claim 8 requires that the guide grooves 14 terminate in a decreasing depth taper 14a for pressing the projection 12 out of the groove. Since none of the references teach the guide groove they cannot and do not teach the specific structure or function

of the guide groove or the taper in the groove. Claim 8 is not obvious over any of the references individually or collectively.

Claim 10

Claim 10 is rejected as being unpatentable as in claim 9 (Meyer and Sakashita) taken with Tiedemann. Claim 9 requires the hook to be in the general shape of a ball having smooth surfaces with spaces for penis glands and claim 10 adds an inert material coating. The examiner rejected the claim in view of Tiedemann in the Appeal Brief on page 19 and is here included by reference.

The publication to Tiedemann is to a non-analogous art, "Port Deaccessor and Methods of Use." Tiedemann teaches a pair of forceps having non-slip coatings. The teaching of Tiedemann that a non-slip coating 25 can be applied to forceps (paragraph 0026) or anything else, does not overcome the deficiencies of Meyer and Sakashita. Neither does it make obvious applying a coating to an enlarged hook or that of using a hook with the structure recited in claim 9.

If the smooth coating of Tiedemann were applied to Meyer or Sakashita they would have difficulty in performing their intended functions of gripping and bending or moving. None of the references teach the claim structure or its use.

Claims 13, 14 and 15

Claims 13, 14 and 15 are rejected as claim 1 (Meyer and Sakashita) taken with Tillier. The examiner rejected the claims including Tillier and it was addressed in the Appeal Brief on pages 19 and 20 and is incorporated here by reference.

As to claims 13 and 14, the patent to Tillier is to a non-analogous art, a “Piston Ring Expanding Tool.” The patent to Tillier teaches a single strip of spring metal bent to form two opposed handles or jaws 5 so that the jaws cross each other at 8 (column 1, lines 42 - 53; Figs 1 and 2). The ends of 9 have tips with recesses 10 to fit over the “square end of a piston ring” (column 2, lines 65 - 70). The handles are forced inwardly to grip and spread a piston ring 11 and are released to spread the ends of the ring (column 2, lines 80 - 86). Tillier has no pivoted ratchet between handles and Tillier has no enlarged hook means as required by parent claim 1. Since neither Meyer, nor Sakashita nor Tillier teach a pivoted ratchet means that prevents closing, or an enlarged hook means as required by Claim 1, they cannot teach or make claim 13 or claim 14 obvious. Further, the end structure 10 of Tillier would tear up any foreskin it was placed in. These references teach away from the claimed structure and function and would be inoperative insofar as the claimed structure of damage avoidance is concerned.

Claims 13 and 14 require the curer to be one integral spring element with cross over that per se is not new. There is no legally sustainable rejection of claim 1 or claims 13 and 14.

Claim 15 depends from claim 13 and is patentable therewith and is independently patentable. Claim 15 additionally sets forth the details of the ratchet 37 and the interaction between the ratchet and handle grip 32 L. Further, there is no teaching of having a handle grip inserted into a cog 38 of a ratchet to secure the distance between the first and second handle grips. Since none of the references teaches the structure or function claimed, the combining of Meyer and Sakashita and Tillier cannot render the claim obvious.

Claim 16

Claim 16 is rejected as claim 2 (Meyer and Sakashita) taken with Roux.

The examiner previously rejected the claim in view of Roux and it was addressed in the Appeal Brief on pages 20 and 21 and is incorporated here by reference.

Claim 16 adds to parent claim 2 that there is a spring with the fulcrum pin for biasing the handle grips.

Claim 16 depends from claim 2 and is patentable therewith. Roux is a patent that is to a non--analogous art, "Extractor for Watch Push Buttons." Both the function of extracting watch push buttons and structure are unrelated to phimosis curing.

The patent to Roux teaches jaws 6 and 7 with the jaw 6 having an outwardly protruding stud 8 having an opening or central recess 10 forming sharp shoulders 12 (Figs 1 and 2, column 2, lines 20 - 34) for engaging a push button and an opposite jaw 7 with a surface 16 for engaging a watch case (column 2, lines 43 - 50). Even if the patents to Roux and Meyer and Sakashita were combinable, adding the spring of Roux into Meyer or Sakashita would not make claim 16 obvious. Roux does not teach a spring ratchet combination as claimed and, like Sakashita, the structure 8,18 of Roux would tear up any foreskin it were placed in. Claim 16 is not obvious over Meyer or Sakashita in view of Roux.

Applicable Law

The legal requirements for rejecting claims have not been met.

35 USC 103(a) Rejections

No legally acceptable obviousness rejection has been made. The references are all drawn to non-analogous art and fail to conform to requirements for combining references and taken together do not teach either the structure or function claimed.

1. Preamble

The references do not meet the Preamble. Claims 1 - 16 are allowable because a phimosis curer is being claimed and not one of the references teaches curing phimosis.

The preamble recites a phimosis curer and the claims clearly address the structure and function, i.e. "insertable into a foreskin opening." "protrude to prevent . . . slipping out of a foreskin," "so that said phimosis curer will not damage the foreskin when it is inserted into the foreskin." As here, when a preamble is essential to understanding the claim itself, the relevant prior art is limited. Freund Industrial Co. V. Driam Metall Product GmbH Co., 12 USPQ 2d 1641 (DCSNY 1989). While the preamble is not normally considered part of the claim, it is deemed part of the claims where necessary to breath "life and meaning" into the claims. Corning Glass Works v. Sumitomo Electric USA, 9 USPQ 2d 1962 (Fed Cir 1989). The purpose set forth in the preamble is more than a mere statement of purpose, it is essential to particularly point out the invention defined by the claims. The limitations appearing in the preamble are necessary to give meaning to the claims and properly define the invention. In re Bullock, 203 USPQ 17 (CCPA 1979); Computervision Corp., 221 USPQ 669 (Fed Cir) cert. Denied, 469 U.S. 857 (1984).

2. Non-analogous Art

The references are not analogous to the invention. Claims 1 - 16 are allowable because the references applied are all from non-analogous arts and are not properly combinable.

Determining non-analogous art is two-fold: first, court decides if reference is within field of inventor's endeavor; if it is not, court proceeds to determine whether reference is reasonably pertinent to particular problem with which inventor was involved. In re Wood and Eversole, 202 USPQ 171 (CCPA 1979). For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. For no matter what a reference teaches, it could not have rendered obvious anything, "at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, " unless said hypothetical person would have considered it. In re Horn, Horn, Horn, and Horn, 203 USPQ 969 (CCPA 1979).

In the instant case, none of the references are from the inventor's field of endeavor, and none of the references address the problem the inventor is solving.

3. Function Ignored

The references do not teach the function or claim wording. Claims 1 - 16 are allowable because not one of the references discloses the wording claimed or the function recited in relation to the claimed structure.

Combining separate teachings in the prior art references must be based on a suggestion or motivation therefor. All words of the claim must be considered in judging the patentability of a claim against the prior art. In re Miller, 169 USPQ 597 (CCPA 1971). A rejection cannot be sustained when the prior art is incapable of functioning as required by the claims and achieving what is achieved by the invention. When this situation exists, the Examiner has failed to make out a prima facie case. Ex parte Gould, 231 USPQ 943 (Bd App 1986). The requirements of a claim cannot simply be ignored. In re Ehrreich et al, 200 USPQ 504 (CCPA 1979). To show obviousness the structure of the references must perform the same function in substantially the same way to produce substantially the same result. Pennwalt Corp. v. Durance Wayland, Inc., 4 USPQ 2d 1737 (CAFC 1987).

4. Problem Addressed

Claims 1 - 16 are allowable because the claims are drawn to the problem of curing phimosis and not one of the references addresses the phimosis problem solution. The claims and references all address different problems.

The prior art must address and provide the inventor's answer to the particular problem confronting an inventor. In re Winslow, 151 USPQ 48 (CCPA 1966). The relationship between the problem the inventor was attempting to solve and the problem to which any prior art reference is directed is highly relevant. Stanley Works v. McKinney Mfg. Co., 216 USPQ 298 (Del DC 1981); In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965).

5. Combining Prior Art References

Claims 1 - 16 are allowable because the references are not properly combinable. There must be a motivation to combine different aspects of an invention. No mechanic in an art would combine one reference with another that would render the first inoperative in whole or in part.

An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. Ex parte Levengood, 28 USPQ 2d 1300 (BdApp 1993). The references must show at least part of the claimed invention. It is fundamental that a valid reference is good for what it discloses and must show all or part of the invention for which a patent is sought. In re Stemple, Jr., 113 USPQ 77 (CCPA 1977). The references combined must have a reasonable chance of success. Criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the combination of references should be carried out and would have a reasonable likelihood of success viewed in the light of prior art. In re Dow Chemical Co., 5 USPQ 2d 1531 (Fed.Cir. 1988). Claims are allowable when nothing in the prior art supports the rejection. Where nothing in the prior art suggests to one of ordinary skill in the art the desirability of combining the features shown in the different references, the claims should be held to be allowable. In re Osweiler, 145 USPQ 691 (CCPA 1965). The claim is allowable when any one element of a combination is not obvious. Where a claim to a combination includes one or more elements that is by itself nonobvious, then the entire claim meets the nonobvious test of 35 USC 103. In re Hirao, 190 USPQ 15 (CCPA 1976).

6. References Require Modification

Claims 1 - 16 are allowable because the references are not properly combinable and the references when combined do not teach the claimed structure.

Patents are references only for what they clearly disclose or suggest. It is not proper use of a reference to modify its structure to one which prior art references do not teach. In re Randal et al, 165 USPQ 586 (CCPA 1979). The totality of the prior art leads away from the claimed invention. In re Hedges, 228 USPQ 685 (CAFC 1986). The claimed device need not necessarily be better than the prior art. A combination of references which requires a change in the basic principle, under which the basic reference was designed to operate, is improper. In re Ratti, 123 USPQ 349 (CCPA 1959).

7. Hindsight rejections.

The rejections are based on hindsight. Claims 1 - 16 are allowable because the random collection of prior art and the interpretation of the prior art clearly indicates an attempt to splice elements from the references into the claimed subject matter based solely on applicant's disclosure. The fact that the prior art elements are being misrepresented and combined in a manner that is inconsistent with their use and that they render the prior art devices inoperative for their intended purposes clearly shows a hindsight reconstruction.

More than an opinion or speculation and hindsight are required to reach a legal conclusion of obviousness. In re Sporck, 133 USPQ 360 (CCPA 1962). A combination rejection must be supported by something other than applicant's own disclosure. In re Shaffer, 108 USPQ 326 (CCPA 1956). To imbue one of ordinary skill in the art with knowledge of the invention, when

no prior art reference or references of record suggest that knowledge is hindsight where that which only the inventor taught is used against its teacher. W.L. Gore & Associates v. Gorlock Inc., 220 USPQ 303 (CAFC 1983); In re Harry Sponnoble, 160 USPQ 237 (CCPA 1969). The use of appellant's disclosure in reconstruction of references to meet claims is barred since, under 35 USC 103, obviousness must be tested at the time the invention was made; and, claims are allowable when the only source which would leave a person of ordinary skill to make the last step in reconstruction is appellant's disclosure. In re Pavlecka, 138 USPQ 152 (CCPA 1963).

35 USC 103(a) SUMMARY

The claims are not obvious:

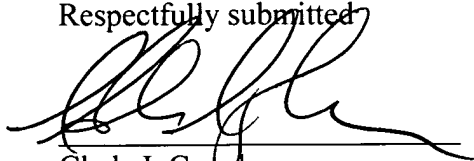
- (a) None of the references are from the inventor's field of endeavor.
- (b) None of the references are from the same art.
- (c) None of the references address the inventor's problem.
- (d) None of the references are properly combined.
- (e) None of the references individually or collectively teach the claim structure.
- (f) None of the references individually or collectively can perform the claim function.
- (g) The rejections are no more than an attempt to collect individual components from extraneous patents and splice them together to reject the claims based only on the claim structure and the examiner's imagination.

The claims define a patentable invention that is not obvious in view of the references of record.

CONCLUSION

Claims 1 - 16 define patentable subject matter and are in condition for allowance. The examiner's rejection of claims 1 - 16 under 35 USC 103(a) as being obvious should be reversed and such action is respectfully requested.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'C. Coughenour', written over a horizontal line.

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viii CLAIMS APPENDIX

Claims on Appeal

Claim 1. A phimosis curer comprising;

a first handle grip having a first end and a second end and a second handle grip having a first end and a second end;

a first jaw having a first end and a second end and a second jaw having a first end and a second end;

a first blade having a first end and a second end and a second blade having a first end and a second end;

said first handle grip second end and said first jaw first end are joined together;

said second handle grip second end and said second jaw first end are joined together;

said first blade first end and said first jaw second end are joined together;

said second blade first end and said second jaw second end are joined together;

said first blade and said second blade extend upwardly from said first jaw and said second jaw respectively so as to be insertable into a foreskin opening;

said first handle grip and said first jaw are joined to said second handle grip and said second jaw such that moving said first handle grip and said second handle grip toward each other moves said first jaw and said second jaw away from each other;

a ratchet means pivots between said first handle grip and said second handle grip adjacent said first handle grip second end and said second handle grip second end;

said ratchet means is designed to selectively prevent said first handle grip and said second handle grip from moving away from each other;

a first enlarged hook means on said first blade second end and a second enlarged hook means on said second blade second end, said first enlarged hook means and said second enlarged hook means having tip sides and front sides and rear sides with said enlarged hook means first and second enlarged hook means tip sides formed so as to protrude, and said rear side of said first elongated hook means and said rear side of said second elongated hook means protrude to prevent said first blade and said second blade from slipping out of a foreskin opening when said first blade and said second blade enlarged hook means front sides are separated within a foreskin opening so that said phimosis curer will not damage the foreskin when it is inserted into the foreskin opening and said blades are separated.

Claim 2. A phimosis curer as in claim 1 including:

a fulcrum pin attaching said first handle grip and said second handle grip together so that said first handle grip and said first jaw can be pivoted relative to said second handle grip and said second jaw.

Claim 3. A phimosis curer as in claim 2 wherein:

said ratchet means includes a curved rack with an upper surface, a lower surface, a first side surface and a second side surface, a first end, a second end, cogs, and a pawl;

said curved rack first end is attached to said first handle grip second end by a first pivot pin;

said pawl is attached to said second handle grip second end by a second pivot pin.

Claim 4. A phimosis curer as in claim 3 wherein:

said curved rack is provided with a slot along its interior length;

said pawl fits within said curved rack slot;

said slot is wide enough to accommodate said pawl in both the engaged position, against said cogs on said curved rack when said first handle grip and said second handle grip are pivoted toward each other, and the disengaged position, away from said cogs on said curved rack, for permitting said first handle grip and said second handle grip to be pivoted away from each other.

Claim 5. A phimosis curer as in claim 3 wherein:

said curved rack is provided with one smooth side surface and one irregular cog surface;

said curved rack irregular cog surface pivots toward said pawl to selectively engage said pawl with said irregular cogs, and away from said pawl to remove said curved rack from contact with said pawl.

Claim 6. A phimosis curer as in claim 3 wherein:

said curved rack lower surface has a guide groove;

said second handle grip second end has a spring-loaded projection;

a stop is positioned on said second handle grip second end on said first side surface of said curved rack second end and said pawl is positioned on said second side surface of said curved rack to limit pivotal movement of said curved rack about said first pivot pin to keep said spring-loaded projection against said curved rack lower surface at all times.

Claim 7. A phimosis curer as in claim 6 wherein:

said spring-loaded projection extends into said guide groove when said guide groove is positioned above it;

said guide groove controls the pivotal movement of said curved rack about said first pivot pin when said projection is in said guide groove to maintain said pawl disengaged from said cogs on said curved rack.

Claim 8. A phimosis curer as in claim 7 wherein:

said guide groove terminates in a decreasing depth taper adjacent to said curved rack second end so that moving said first handle grip and said second handle grip away from each other pushes said projection from said guide groove by pressing said projection into said second handle grip;

resilient means bias said curved rack toward said pawl to maintain said pawl in engagement with said cogs when said projection is released from said guide groove.

Claim 9. A phimosis curer as in claim 1 wherein:

said enlarged hook means are in the general shape of a ball with finished smooth curved surfaces and with spaces provided to preclude damage to the penis glands and from pinching the foreskin.

Claim 10. A phimosis curer as in claim 9 wherein:

said enlarged hook means are coated with an inert material not harmful to the human body.

Claim 11. A phimosis curer as in claim 1 wherein:

said first handle grip and said first jaw and said first blade and said first enlarged hook means are one integral part;

said second handle grip and said second jaw and said second blade and said second enlarged hook means are one integral part.

Claim 12. A phimosis curer as in claim 3 wherein:

a bias means with said first pivot pin for biasing said cogs on said ratchet means curved rack toward said pawl.

Claim 13. A phimosis curer as in claim 1 wherein:

said first handle grip and said first jaw and said first blade and said first enlarged hook means and said second handle grip and said second jaw and said second blade and said second enlarged hook means are all one integral shaped spring element.

Claim 14. A phimosis curer as in claim 13 wherein:

said first handle grip first end and said second handle grip first end are united together;

said first jaw and said second jaw criss-cross each other.

Claim 15. A phimosis curer as in claim 13 wherein:

said ratchet means has a flat rack having a first side edge and a second side edge;

said flat rack is attached to said second handle grip;

cogs are formed along said flat rack first side edge;

said ratchet means is engaged by selectively placing said first handle grip into one of said cogs on said flat rack first side.

Claim 16. A phimosis curer as in claim 2 including:

a spring with said fulcrum pin for biasing said first handle grip and said second handle grip away from each other.

References relied on by the Examiner:

Tillier, U.S. 1,477,786, issued 18 December 1923

Roux, U.S. 4,124,929, issued 14 November 1978

Cox, U.S. 4,754,746, issued 5 July 1988

Tiedemann, U.S. 2003/0233119, published 18 December 2003

Meyer, U.S. 6,325,625, issued 4 December 2001

Sakashita, U.S. 5,370,659 issued 6 December 1994

Seber et al, U.SI 6,748,829 issued 15 June 2004

x RELATED PROCEEDINGS APPENDIX

There are no known proceedings that relate to this application.